

## **REMARKS**

### **Status of the Claims**

Claims 1–50 were pending in this application and stand rejected.

Claim 42 is amended herein. No new matter is introduced.

Claims 18, 19, and 43 are cancelled herein without prejudice or disclaimer.

### **Claim Rejections**

#### **Double Patenting**

The Examiner has provisionally rejected claims 1-50 on the ground of obviousness-type double patenting over co-pending applications Ser. No. 10/532,361 and Ser. No. 10/331,069. Inasmuch as these are provisional rejections, Applicants respectfully request that it be held in abeyance pending the determination of patentable subject matter. Please note that Ser. No. 10/532,362 has been abandoned by not responding to the Office Action mailed July 17, 2009. Accordingly, the provisional double patenting rejection is moot with respect to that application.

#### **§112 (indefiniteness)**

The Examiner has rejected claims 18 and 19 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Applicants disagree with the rejection and submit that one skilled in the art would have no difficulty ascertaining the metes and bounds of the water rinseable composition, on the one hand, and the water resistant composition, on the other, as originally claimed. However, solely to expedite allowance, and without waiver or disclaimer of Applicant's right to pursue the identical subject matter in one or more continuing applications, claims 18 and 19 are canceled herein, thus rendering the rejection moot.

The Examiner has rejected claim 42 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to specify the amount "sufficient to mask the color." Applicants traverse this rejection and submit that one skilled in the art would understand, based on a reading of the instant application, that many foams are white in appearance due to the interaction of light with the cellular structure of the foam. For example, many shaving gels use dyes to impart a colored appearance to the gel. However, when the same gel begins to foam, the initial color is lost and the foam takes on a white appearance. Typically, a mascara is highly

pigmented and intended to provide a strong coloring effect to the lashes and the use of a foam may therefore appear incompatible with a mascara. However, the invention solves this problem by selecting levels of pigments such that the composition appears colored even after the foam has expanded. See p. 14, line 23–p.15, line 10. For additional clarity, claim 42 is amended herein to call for “pigment in an amount sufficient to impart a color other than white to the composition when it is foamed.” This amendment finds support throughout the specification as filed, in particular on page 14, lines 26–29, wherein it is disclosed that the “composition of the present invention, optionally, incorporates one or more colorants in an amount sufficient to mask the color of the foam, which is usually white, so that when the composition of the present invention is applied to the hair, it imparts a color thereto other than white.” Applicant respectfully submits that one skilled in the art would have no difficulty understanding what amount of pigment is required to mask the white appearance of a given foam composition. Claim 43 also stands rejected under 35 U.S.C. §112, second paragraph, as allegedly lacking antecedent basis, however, in view of the cancellation thereof, the rejection is moot.

### **§112 (written description)**

The Examiner rejects claims 1-50 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. The Examiner’s contention appears to be that various functional limitations of the claims (e.g., “produce a foam on the hair fibers and thereby produce an expanded composition,” “a volumizing effect is imparted,” etc.) Applicants submit that the Examiner’s position is inconsistent with the law and respectfully request reconsideration and withdrawal of the rejection.

“There is a **strong presumption** that an adequate written description of the claimed invention is present when the application is filed” and “[c]onsequently, **rejection of an original claim for lack of written description should be rare.**” MPEP § 2163; In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”). The claims rejected by the Examiner are those **originally filed** in this application and the Examiner clearly has not met this burden. One needs to look no further than the claims as filed for written description, although the remainder of the specification is also replete with additional, essentially

verbatim, support. For example, the application discloses that “[w]hen the post-expanding composition of the present invention is applied on hair fibers, such as eyelashes, the volatile agent will release and cause the surfactant and solvent for the surfactant to swell/expand the composition. When the film forming agent sets, it fixes at least a portion of the swelled/expanded composition on the eyelashes in its swelled/expanded state, thereby imparting a volumizing effect to the eyelashes.” See p. 13, lines 15-20. It cannot reasonably be said that one skilled in the art would question whether the inventors were in possession of the invention recited in this passage and claimed in the originally filed claims.

This is not, for example, a case where a composition is claimed solely by functional limitations without a known structure-function correlation, see Regents of the University of California v. Eli Lilly, 119 F.3d 1559 (Fed. Cir. 1997), or where treatment based on a biological mechanism or action is claimed without identifying a single suitable drug, see Univ. of Rochester v. G.D. Searle & Co., 358 F.3d 916 (Fed. Cir. 2004), nor does the Examiner contend that a critical element is omitted from the claims, see Gentry Gallery v. Berkline Corp., 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998).

Rather, the Examiner’s sole contention appears to be that Example 13 of the instant application is drafted prophetically, in that it states that “The mascara composition of Example 2 through 12 when tested in the manner described above *will* show a definite change in surface area. That is, it *will* be observed that after application of the post-application expanding composition to the eyelash, the composition will begin to swell/expand such that the radius of the composition encasing the lash appears to steadily increase . . .” (p. 22, lines 23-27). However, the prophetic nature of Example 13 does not evidence a lack of possession for at least the reason that “**examples are not necessary to support the adequacy of a written description.**” See Falkner v. Inglis, 448 F.3d 1357, 1366 (Fed. Cir. 2006). Indeed, it is not even necessary that an invention be reduced to practice to satisfy the written description requirement. Id. At the minimum, the prophetic disclosure cited by the Examiner supports, rather than negates, written description because it demonstrates that the inventors broadly considered these function attributes to be part of the invention and did not intend to be limited to specific compositions. Reconsideration and withdrawal of the written description rejection is respectfully requested.

**CONCLUSION**

Applicant respectfully submits that the instant application is in condition for allowance. In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

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